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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,628	03/10/2000	Frederic Petit	10655.7500	5109

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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,628

Applicant(s)

PETIT, FREDERIC

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-33 have been examined.

Priority

2. Acknowledgment is made of applicant's claiming the benefit of U.S. Provisional Application No. 60/123,775, filed March 11, 1999.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-8, 10-12, and 19-22 are rejected under 35 U.S.C. 102 (e) being anticipated by Virgil M. Davis et. al., U.S. Patent No. 6,105,008.

As per claims 1 and 19, Davis discloses; a system for downloading information to an information device, comprising:

of an information device (See Davis figures 17,18A,18B, 18C)

at least one external device capable of transferring blocks of information

an acknowledgment process, wherein said acknowledgment process produces a verifiable

acknowledgement of the transferred information (See Davis figures 17,18A,18B, 18C, and 18D column 4, lines 26-37, column 6, lines 50-68, and column 25, lines 20-55).

As per claims 2-5, 20, Davis discloses the limitations of claims 1 and 2. Davis further discloses; the verifiable acknowledgment is transmitted to said information owner and can only be interpreted by the information owner, in addition to be uniquely related to the transferred information it can be tested and

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validated by the information owner (See Davis figures 18A, and 18B column 26, lines 28-68 and column 27, lines 1-22).

As per claims 6-8, 21, 22, Davis discloses the limitations of claims 1 and 19. Davis further discloses;

The external device is remotely located from said information owner and wherein said external device transfers the blocks of information on behalf of said information owner. The information device is a smart card, in addition, a card reader, wherein said smart card communicates with said external device via said card reader (See Davis figures 16 and 17 and column 4, lines 1-5 and lines 26-37, column 5, lines 3-13).

As per claims 10-12, Davis discloses the limitations of claim 1. Davis further discloses; said acknowledgment process uses cryptography to produce the verifiable acknowledgement of the transferred information. This process is resident on said information device and at least one network, wherein the network facilitates communications among said information owner, said external device and said information device (See Davis Figures 16 and 17 column 4, lines 26-36, column 5, lines 3-13 and lines 22-39).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 13, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Virgil M. Davis et al., U.S. Patent No. 6,105,008 in view of U.S. Patent No. 5,590,038 to Satyan G. Pitroda.

As for claims 9 and 23-24, Davis discloses all the limitations of claims 1 and 19. What Davis is not explicit on its teaching is using of a more sophisticated type of processing unit such as a PDA. However,

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Pitroda clearly teaches the usage of more sophisticated devices/cards that are capable of more extensive processes that are utilized in PDAs. Such process as scheduler, reminders, data bases of numbers and names and such (See Pitroda column 12, lines 7-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the well known usefulness of having the processing power of a PDA in place of a limited power of a Smart Card. Additionally, the power of PDAs are well known, this would have been highly beneficial in conjunction with efficiency of processing information and data. This would have been beneficial on the processing and speed of processing in addition to amount of memory available to the users.

As per claim 13 and 24, Davis discloses the limitations of claims 1 and 19. What Davis is not explicit is teaching the; information download is new information or data to be stored on said information device. However, Pitroda clearly teaches the information download is new information (See Pitroda column 11, lines 39-68 and column 12, lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the teachings of Pitroda with the teaching of Davis to greatly expand the capability of the Davis's invention to new data and applications.

7. Claims 14-18 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Virgil M. Davis et al., U.S. Patent No. 6,105,008 in view of "Smart Card Handbook", W. Rankl and W. Effing, 1997, John Wiley & Sons and "A New High-Security, Multi-Application Smart Card Jointly Developed by Bull and Philips", Peter Schnable, 1991, International Smart Card 2000 Conference.

As per claims 14-18, and 25-29, Davis discloses the limitations of claims 1 and 19. What Davis is not explicit is teaching the; information download is an update of existing information, a deletion of existing information, an applet, an application, or data to be stored on said information device. However, both Rankl and Schnable clearly teach the nature of transfer of information between a source and a Smart Card is constituted of data. Operating system, applications (Applets, etc.) are routinely loaded into different information processing devices and updated, erased, replaced, and additional functionality

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added to them (See Rankl and Schnable). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to combine the teachings of Davis, Rankl, and Schnable to achieve more flexibly on the information processing power of the system proposed by Davis's invention.

8. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Virgil M. Davis et al., U.S. Patent No. 6,105,008 in view of U.S. Patent No. 5,590,038 to Satyan G. Pitroda.

As per claim 30, Davis discloses an updated information device wherein; an acknowledgment process, wherein said acknowledgment process produces a verifiable acknowledgement of the transferred information (See Davis figures 17, 18A, 18B, 18C, and 18D column 4, lines 26-37, column 6, lines 50-68, and column 25, lines 20-55). Davis additionally discloses that the verifiable acknowledgment is transmitted to a validating party, the acknowledgment in addition to be uniquely related to the transferred information it can be tested and validated by the validating party (See Davis figures 18A, and 18B column 26, lines 28-68 and column 27, lines 1-22). What Davis is not explicit on the information device is initially configured to be updatable. However, Pitroda clearly teaches that information on a Smart Card is updateable (See Pitroda column 16, lines 50-60 and claims 15 and 16). Additionally, it would have been beneficial to have the Smart Card capable of changing information on it so that the applications running in the Smart Card is upgradeable and data related to the Smart Card can be changed, deleted, and replaced with new data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to use upgradeable Smart Cards for ease of use and change of application and data within the Smart card.

As per claim 33, Davis and Pitroda disclose the limitations of Claim 30, wherein the updated information device is a information processing unit. What Davis is not explicit on its teaching is using of a more sophisticated type of processing unit such as a PDA. However, Pitroda clearly teaches the usage of more sophisticated devices/cards that are capable of more extensive processes that are utilized in PDAs. Such process as scheduler, reminders, data bases of numbers and names and such (See Pitroda column

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12, lines 7-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the well known usefulness of having the processing power of a PDA in place of a limited power of a Smart Card. Additionally, the power of PDAs are well known, this would have been highly beneficial in conjunction with efficiency of processing information and data. This would have been beneficial on the processing and speed of processing in addition to amount of memory available to the users.

As per claim 31, Davis and Pitroda disclose the limitations of Claim 30, wherein the validating party is a second party and wherein the second party delegated said download of information to the first party (See Davis column 24, lines 49-60).

As per claim 32, Davis and Pitroda disclose the limitations of Claim 30, wherein the updated information device is a smart card (See Davis figures 16 and 17 and column 4, lines 1-5 and lines 26-37, column 5, lines 3-13).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure
U.S. Patent to:

U.S. Patent No. 5,444,861 to William B. Adamec, System for Downloading Software.

U.S. Patent No. 5,999,740 to David John Rowley, Updating Mechanism for Software.

U.S. Patent No. 6,173,401 to Michael Deindl, Importing Information onto A Chip Card.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

Crystal Park 5, 2451 Crystal Drive

7th floor receptionist, Arlington, VA, 22202

Abdi/K

July 8, 2002



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